

REMARKS

Based on the amendments above, claims 12 and 14-36 are pending in this application. Claim 13 has been canceled. Claim 12 has been amended to include the features of canceled claim 13. Claims 16 and 27-29 have been amended to correct typographical errors. No new matter has been added. Applicant further submits herewith the Declaration of John K. Eckl Under 37 C.F.R. 1.131 in support of the present application.

I. Response to the Examiner's Comments on the Sklar Declaration

In the February 7, 2002 Office Action, the Examiner stated that the Declaration of Lawrence Sklar, submitted on July 12, 2001 was ineffective to overcome the 35 U.S.C. § 103 obviousness rejections based U.S. Patent 5,802,498 to Comesanas ("Comesanas"). Comesanas was filed on January 11, 1996 and issued September 1, 1998. The present application claims a priority from a prior application filed on December 23, 1996. Accordingly, the Examiner appears rely on Comesanas as qualifying as prior art under the provisions of 35 U.S.C. § 102(e).

Under § 102(e), a reference is available as prior art if it is "a patent granted on an application for patent by another *filed in the United States before the invention thereof by the applicant. . . .*" 35 U.S.C. § 102(e) (emphasis added). It is respectfully submitted that Comesanas is not available as a § 102(e) reference for the present application because the applicant for the present application made his invention prior to the January 11, 1996 "102(e) date" of that reference. This prior invention is evidenced in the Declaration of Lawrence Sklar, previously filed, and the declaration of John Eckl, filed herewith, along with the supporting exhibits.

Specific responses to the Examiner's comments are provided below.

A. *Declaration Signed by Person Other Than Inventor*

The Examiner stated that the Declaration of Lawrence Sklar was "inappropriate because it was executed and signed by a person other than the inventor." Instead, the declaration was made by the patent attorney responsible for preparing the original patent application.

Typically, subject to a few exceptions, a declaration under 37 C.F.R. 1.131 is made by "the inventor of the subject matter of the rejected claim." In contrast, a declaration under 37 C.F.R. 1.132 provides for submittal of "any evidence submitted to traverse the rejection." Accordingly, it is requested that the Declaration of Lawrence Sklar be considered under the provisions of 37 C.F.R. 1.132 to the extent that § 1.131 has been deemed inappropriate. The Declaration of Lawrence Sklar includes information pertinent to the date of invention for the present application, and accordingly its label as a declaration under § 1.131 or § 1.132 should not affect its substantive merits relating to overcoming the Comesanas reference.

Applicant has also filed a Declaration of John Eckl, herewith. John Eckl is the inventor for the present application, and thus is clearly an appropriate declarant under § 1.131. It is requested that the two corroborating declarations be considered together in overcoming Comesanas.

B. *Substantial Gaps in Time*

The Examiner stated that "there are substantial gaps in time between the applicant's first disclosure of the concept of the invention in July 1995, the authorization for the applicant to proceed with reducing the invention to practice in February 1996, the decision to file a patent application in June 1996, and the actual filing of the application in December of 1996."

Applicant traverses the Examiner's characterization of the "gaps." For the time spans identified, the Applicant has supplied evidence describing activity that was occurring during those spans. The Examiner should not focus on certain key events,

and then ignore the work that is described as occurring between those events. Accordingly, the efforts of Applicant and of the intellectual property law department during those spans to perform the tasks of investigating the patentability of the invention, preparing for committee meetings to review inventions, investigating technical aspects of the invention, preparing the drawings and written specification for the application, and comparing the invention to known prior art, are all evidence indicating ongoing activity in support of filing of the application in December of 1996.

Further, the patent laws do not require continuous non-stop activity when there is a reasonable excuse for inactivity or activity on other matters. "An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused." MPEP 715.07(a). Thus, for example, attorney Sklar's heavy responsibilities and activities at Pitney Bowes including advising clients on trademark, copyright, and business matters excuses him from spending all of his time drafting the original patent application. Also, it is submitted that the periodic review of batches of invention disclosures, as described in the Declarations, is reasonable and consistent with diligence on the part of Applicant, and the intellectual property organization at Pitney Bowes. "Diligence must be judged on the basis of the particular facts in each case." MPEP 715.07(a).

II. Claim Objections

The Examiner objected to formal errors in claims 16, 27, 28, and 29. The above amendments have corrected those errors in the manner suggested by the Examiner. It is requested that these objections be withdrawn.

III. Rejections Under 35 U.S.C. § 103

All of the Examiner's rejections under 35 U.S.C. § 103 rely on Comesanas as teaching various features of the claimed invention. Because Comesanas should be

disqualified as prior art, as evidenced by the prior invention described in the submitted declarations and exhibits, all of these rejections should be withdrawn accordingly.

Even if Comesanas were considered to be valid prior art, its teachings and descriptions are insufficient to support the rejections of the claims as amended. The specific grounds for these rejections are addressed below.

A. Rejections based solely on Comesanas

Claims 12, 14, 15, 17-23, 25-27, 29-34, and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Comesanas. These rejected claims relate to a billing system capable of transmitting bills in an electronic or printed format, the transmittal format based on prescribed preferences of the recipient. This basic feature of the invention, as recited in all of the pending independent claims, is not described or suggested in the Comesanas reference. Pertinent recitals in the independent claims are as follows:

Independent claim 12 recites a "lookup table containing delivery preferences for the at least one recipient indicating whether a billing statement is to be transmitted by a said printed transmission or electronic transmission, said routing means routing billing information in accordance with said delivery preferences."

Independent claim 18 recites steps of "prescribing delivery preferences for said billing information" and "associating said delivery preferences with said billing information to determine if said billing information is to be transmitted via printed transmission or electronic transmission."

Independent claim 21 recites "means for extracting from a database the prescribed delivery preference corresponding to each said isolated record" and "means for determining whether each of said records is intended for printed transmission or electronic transmission in dependence upon said extracted prescribed delivery preference."

Independent claim 26 recites "extracting from a database the prescribed delivery preference corresponding to each said isolated record" and "determining whether each of said records is intended for printed transmission or electronic transmission in dependence upon said extracted prescribed delivery preference."

Finally, independent claim 30 recites "a server coupled to said switch, said server comprising: means for determining whether each of said records is intended for printed transmission or electronic transmission in dependence upon the prescribed delivery preference of the corresponding recipient; means for converting billing information to a format appropriate for electronic transmission and generating an electronic billing statement from the billing information."

Comesanas is directed towards a system by which a customer can pre-authorize return transmittal charges to be added to charges in a billing statement. Upon such pre-authorization, a biller can include a pre-paid return envelope with a bill, and a charge for the return envelope will be included in the statement. Comesanas also states that such transmittal charges may be pre-authorized in a system that utilizes electronic transmittal of payments.

Because Comesanas is directed to a different system with a different purpose than the present invention, there is scant overlap of subject matter. However, Comesanas does point out that his pre-authorization scheme is applicable to either a system using printed transmittal or a system using electronic transmittal. It is from this reference to both types of transmittal that the Examiner appears to draw the unsupported conclusion that missing claim recitals are somehow suggested.

Comesanas, however, makes no mention that use of printed or electronic transmittal is based on "prescribed preferences" of the customers, and that the billing information will be routed according to those preferences. Instead of these claimed features of the present invention, Comesanas provides that a user can provide pre-authorization for the pre-paid transmittal charge. There is no mention or suggestion of a

choice of type of transmittal method by the customer. Comesanas includes no teaching or suggestion that the choice of transmittal method has anything to do with the preferences of the user, ^{Comesanas only} which only relate to whether or not to pre-authorize transmittal charges.

It is only through impermissible hindsight that Comesanas' mere description of two forms of transmittal can be asserted as making the present claims unpatentable. A customer's preference for electronic or printed transmittal is nowhere addressed in Comesanas. Accordingly, it is respectfully submitted that the rejections of independent claims 12, 21, 26, and 30 and their respective dependent claims in view of Comesanas should be withdrawn.

B. *Rejections Based on Comesanas in View of Hogan*

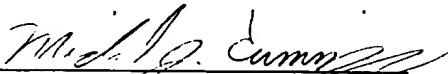
Claims 16, 24, 28, and 35 stand rejected as being unpatentable over Comesanas in view of U.S. Patent 5,699,528 to Hogan ("Hogan"). As discussed above, the claims of the present application recite the selection of printed or electronic transmittal based on prescribed customer preferences, a feature not described or suggested by Comesanas.

Hogan describes an electronic billing system including various features, but that fails to describe or suggest the features noted above as missing from Comesanas. Accordingly, Hogan does not cure the defects of Comesanas described above and claims 16, 24, 28, and 35 should be allowable for the same reasons.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that the claims of this application are in a condition for allowance and favorable action thereon is requested.

Respectfully submitted,


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Signature

June 4, 2002
Date

Version with Markings to Show Changes Made

In the Claims:

Cancel claim 13.

Please amend claims 12, 16, 18, 27, 28, and 29

12. A billing system for delivering billing statements from a biller to a recipient by means of a printed transmission or electronic transmission, comprising:

a billing server coupled to a biller's computer operative to receive billing information from said biller's computer and determine whether said billing information is intended for said printed transmission or said electronic transmission;

a printer operably connected to said server operative to generate a printed billing statement from said billing information;

an electronic information server operably connected to said billing server, said electronic information server operative to convert said billing information for electronic transmission and generate an electronic billing statement from said billing information and electronically transmit the electronic billing statement to the at least one recipient over a communications network; ~~and~~

routing means coupled to said billing server for routing said billing information to said printer if said billing statement is determined to be transmitted by said printed transmission and to said electronic information server if said billing statement is determined to be transmitted by said electronic transmission; and

a lookup table coupled to said billing server, said lookup table containing delivery preferences for the at least one recipient indicating whether a billing statement is to be

transmitted by a said printed transmission or electronic transmission, said routing means routing billing information in accordance with said delivery preferences.

16. A billing system as recited in claim 12 wherein the electronic information server includes means for determining whether or not a said recipient ~~as~~ has retrieved a transmitted electronic billing statement.

18. A method for delivering billing statements from a biller to a recipient by means of a printed transmission or electronic transmission, comprising the steps of:

generate billing information for at least one recipient from a biller's computer;

prescribing delivery preferences for said billing information;

~~associated~~ associating said delivery preferences with said billing information to determine if said billing information is to be transmitted via printed transmission or electronic transmission;

generating a printed billing statement from said billing information if said billing information was determined to be transmitted via printed transmission;

converting said billing information for electronic transmission if said billing information was determined to be transmitted via electronic transmission; and

generating an electronic billing statement from said converted billing information if said billing information was determined to be transmitted via electronic transmission.

27. A method according to claim 2426, further comprising storing the prescribed delivery preferences in said database prior to the generation of said billing information.

28. A method according to claim ~~24~~26, further comprising determining whether said recipients to whom electronic billing statements have been electronically transmitted have retrieved said electronic billing statements.

29. A method according to claim ~~24~~26, further comprising electronically transmitting funds from said recipients to a biller for whom said billing information is generated.